

REMARKS

In response to the Restriction Requirement, Applicant elects Group I (Claims 1-3), with traverse.

Applicant traverses the Requirement for Restriction between Groups I and II because the facts, as stated by the Examiner, do not meet the legal requirements for a proper Restriction.

MPEP §803 states the requirements for a restriction requirement:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - § 806.05(i)); and
- (2) There must be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §806.04(a)-(j), §808.01(a) and §808.02).

MPEP §806.05(e) clarifies that

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.

If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention.

Independent Claim 4 of the present invention recites "means for imparting an electrochemical dissolving effect to each machined surface of multiple workpieces, each of said workpieces serving as a part of said fluid dynamic pressure bearing; and means for forming at least one fluid dynamic pressure groove on said each machined surface, said groove having a

specified shape, dimension and surface condition, wherein the same electrolyte is directed from a common electrolyte tank to each machining device used on said multiple workpieces." In the Office Action, the Examiner indicated that the apparatus of Claims 4-6 may be used to practice electroplating. (Office Action, page 2). Applicants respectfully disagree with the Examiner for the following reasons:

- 1) A "means for imparting an electrochemical dissolving effect" removes material from the surface of a workpiece, while an electroplating process is a process of depositing material on the surface of workpiece. Thus, at least one element of Claim 4 performs the function that would make the process of electroplating impossible.
- 2) In order to deposit material on a surface, the electrolyte should be at rest in a tank because movement of an electrolyte will prevent metal-ions from depositing properly on the surface of a workpiece. In contrast, the speed of an electrolyte flow must be high in an electrochemical process to remove the dissolved metal ions as soon as possible. See, for example, paragraph [0015] of the specification for more detailed explanation. Amended Claim 4 recites that the electrolyte is directed from a common electrolyte tank to each of said machining devices, i.e., the electrolyte moves from a common electrolyte tank to each of the machining devices. Therefore, this element would also prevent the apparatus of Claim 4 from being used in an electroplating process.

Therefore, the first requirement of MPEP §803 is not satisfied.

MPEP §803 further clarifies (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The Examiner's paper omits any mention of criterion (2) — the Restriction raises no showing of a serious search burden. At a minimum, a Restriction Requirement without such a showing is incomplete.

Applicants suggest that the search burden is unlikely to be "serious" when all limitations of Claim 1 (the independent claim of Group I) appear nearly word-for-word in Claim 4 of Group II. Claim 1 will be searched in any event. Therefore, it seems that a search of Group I will necessarily result in a search of the independent claim of Group II as well.

In view of the above, Applicants request that the Restriction between Groups I and II be withdrawn.

Should the requirement for restriction be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

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The Examiner is urged to telephone Applicant's counsel of record at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-0675, Order No. 051319-45.

Respectfully submitted,

Date: February 21, 2006

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